



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,832	10/15/2001	Guanglu Wang	01-1013	4510

7590

07/01/2005

McDonnell Boehnen Hulbert & Berghoff
32nd Floor
300 S. Wacker Drive
Chicago, IL 60606

EXAMINER

JEAN GILLES, JUDE

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,832

Applicant(s)

WANG ET AL.

Examiner

Jude J. Jean-Gilles

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Action is in regards to the Reply received on 23 March, 2005.

Response to Amendment

1. This action is responsive to the application filed on 23 March, 2005. Claims 11-14 have been deleted. Claims 1, 6, 15, 16, and 17 have been amended. Claims 1-10, and 15-17 are pending, and represent a method and system for a "sidebar functionality in a regular conference system".

Response to Arguments

2. Applicant's arguments with respect to claims 1, 6, 15, 16, and 17 have been carefully considered, but are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new ground of rejection as explained here below, necessitated by Applicant substantial amendment (i.e., a method wherein the audio stream of the first user and the audio stream of the second user are only audible to the first user and the second user) to the claims which significantly affected the scope thereof.

The dependent claims stand rejected as articulated in the First Office Action and all objections not addressed in Applicant's response are herein reiterated.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirni et al (U.S. Patent No. 6,731,609 B1) in view of Beyda et al (U.S. Patent No. 6,404,873).

Regarding claim 1: Hirni et al disclose the invention substantially as claimed.

Hirni et al teach a method of conferencing (*column 15, lines 9-14*), the method comprising:

establishing a conference between a first user, the first user having an audio stream, and a second user, the second user having an audio stream, the conference having an audio stream (*fig. 2A, items 43-43', and 44; column 6, lines 14-21; column 30, lines 3; column 3, lines 40-42; note that the audio of the agent is the audio of the conference*);

creating a temporary conference (*fig. 2A, items 43-43', and 44; column 6, lines 14-21*);

directing the audio stream of the conference (*column 10, lines 60-62*) to the temporary call conference; and

Hirni et al further teach directing the audio stream of the first user to the temporary conference; and directing the audio stream of the second user to the temporary call conference, (*column 10, lines 63-67*). However, Hirni et al fail to specifically disclose a method of sidebar conference wherein, the audio stream of the first user and the audio stream of the second user are only audible to the first user and the second user.

In the same field of endeavor, Beyda et al disclose "*a subconference system and method...enabling conferees to establish subconferences during the main conference while still being able to listen in the main conference conversations...and that the existence of the subconference call is shielded from the other conferees.*" [see Beyda; *column 7, lines 44-56*]. In the same paragraph Beyda also teaches in details the temporary conference call of the step above.

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Beyda et al's teachings of using a sidebar with the teachings of Hirni et al, for the purpose of improving the ability of a network "*...to provide method for establishing and managing a secondary subconference call within a conference call...*" as stated by Beyda in lines 10-12 of column 4. By this rationale, **claim 1** is rejected.

Regarding claims 2, and 7: The combination Hirni- Beyda discloses the method of claim 1 and the system of claim 6, further comprising prompting the first user for information indicating the identity of the second user [see Beyda; column 4, lines 30-

Art Unit: 2143

48]. The same motivation that was used for claim 1 is also valid for claims 2 and 7[see Beyda, column 7, lines 44-56]. By this rationale, **claims 2 and 7** are rejected.

Regarding claims 3, and 8: The combination Hirni- Beyda teaches the method of claim 2, and the system of claim 7, wherein prompting the user includes presenting a menu to the user [see Beyda; column 4, lines 30-48]. The same motivation that was used for claim 1 is also valid for claims 3 and 8 [see Beyda, column 7, lines 44-56]. By this rationale, **claims 3 and 8** are rejected.

Regarding claim 4, and 9: The combination Hirni- Beyda teaches the method of claim 2, and the system of claim 7 further comprising receiving and processing voice commands from the first user [see Beyda; column 5, lines 30-47]. The same motivation that was used for claim 1 is also valid for claims 4 and 9 [see Beyda, column 7, lines 44-56]. By this rationale **claims 4, and 9** are rejected.

Regarding claim 5, and 10: The combination Hirni- Beyda teaches the method of claim 1, and the system of claim 6, further comprising determining whether the second user desires to enter the sidebar with the first user [see Beyda; column 6, lines 35-60]. The same motivation that was used for claim 1 is also valid for claims 5 and 10 [see Beyda, column 7, lines 44-56]. By this rationale **claims 5, and 10** are rejected.

Regarding claim 6: The combination Hirni- Beyda discloses a device for conducting a sidebar conference [see Beyda; *fig. 1, items 30*] between a first user and a second user, the device comprising:

means for establishing a call conference between a first user, the first user having an audio stream, and a second user, the second user having an audio stream,

Art Unit: 2143

the conference having an audio stream [see *Hirni*; *fig. 2A*, *items 43-43'*, and *44*; *column 6*, *lines 14-21*; *column 30*, *lines 3*; *column 3*, *lines 40-42*; note that the audio of the agent is the audio of the conference];

means for creating a temporary call conference [see *Hirni*; *fig. 2A*, *items 43-43'*, and *44*; *column 6*, *lines 14-21*];

means for directing the audio stream of the conference to the temporary call conference [see *Hirni*; *column 10*, *lines 60-62*]; and

means for directing the audio stream of the first user to the temporary conference and directing the audio stream of the second user to the temporary conference wherein the audio stream of the first user and the audio stream of the second user are only audible to the user and the second user [see *Beyda* ; *column 7*, *lines 44-56*; see *Hirni*; *column 10*, *lines 63-67*]. The same motivation that was used for claim 1 is also valid for claim 6 [see *Beyda*, *column 7*, *lines 44-56*]. By this rationale **claim 6** is rejected.

Regarding claim 15: The combination *Hirni*- *Beyda* teaches a method for establishing a sidebar conference [see *Beyda*; *fig. 1*, *items 30*] between a first user and a second user, within a on-going conference, the on-going conference having an audio stream, the first user having an audio stream, the second user having an audio stream, the method comprising the steps of:

directing the audio stream of the conference to the sidebar conference [see *Hirni*; *column 10*, *lines 60-62*]; and

directing the audio stream of the first user to the temporary conference and directing the audio stream of the second user to the temporary conference, wherein the audio stream of the first user and the audio stream of the second user are only audible to the first user and the second user [see Beyda ; *column 7, lines 44-56*; see Hirni; *column 10, lines 63-67*]. The same motivation that was used for claim 1 is also valid for claim 15[see Beyda, column 7, lines 44-56]. By this rationale **claim 15** is rejected.

Regarding claim 16: The combination Hirni- Beyda teaches a computer program [see Hirni; *column 41, lines 41-54*] for establishing a sidebar conference [see Beyda; *fig. 1, items 30*], the program comprising:

first code for establishing a conference between a first user, the first user having an audio stream, and a second user, the second user having an audio stream, the conference having an audio stream [see Hirni; *fig. 2A, items 43-43', and 44; column 6, lines 14-21; column 30, lines 3; column 3, lines 40-42; note that the audio of the agent is the audio of the conference*];

second code for creating a temporary conference [see Hirni; *fig. 2A, items 43-43', and 44; column 6, lines 14-21*];

third code for directing the audio stream of the conference to the sidebar conference [see Hirni; *column 10, lines 60-62*]; and

fourth code for directing the audio stream of the first user to the temporary conference and directing the audio stream of the second user to the temporary conference, wherein the audio stream of first user and the audio stream of the second user are only audible to the first user and the second user [see Hirni; *column 10, lines*

Art Unit: 2143

63-67]. The same motivation that was used for claim 1 is also valid for claim 16 [see Beyda, column 7, lines 44-56]. By this rationale **claim 16** is rejected.

Regarding claim 17: The combination Hirni- Beyda teaches a computer readable medium having stored therein instructions for causing a processing unit to execute the following method [see Hirni; *column 41, lines 41-54; column 8, lines 25-35; fig. 3, item 46, 50, 54*]:

establishing a conference [see Beyda; *fig. 1, items 30*], between a first user, the first user having an audio stream, and a second user, the second user having an audio stream, the conference having an audio stream [see Hirni; *fig. 2A, items 43-43', and 44; column 6, lines 14-21; column 30, lines 3; column 3, lines 40-42; note that the audio of the agent is the audio of the conference*];

creating a temporary conference [see Hirni; *fig. 2A, items 43-43', and 44; column 6, lines 14-21*]; directing the audio stream of the conference to the sidebar conference [see Hirni; *column 10, lines 60-62*]; and

directing the audio stream of the first user to the temporary conference; and directing the audio stream of the second user to the temporary conference, wherein the audio stream of first user and the audio stream of the second user are only audible to the first user and the second user [see Beyda ; *column 7, lines 44-56; see Hirni; column 10, lines 63-67*]. The same motivation that was used for claim 1 is also valid for claim 17 [see Beyda, column 7, lines 44-56]. By this rationale **claim 17** is rejected.

Response to Arguments

5. Applicant's Request for Reconsideration filed on 23 March, 2005 has been carefully considered but is not deemed fully persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address Applicants' main points of contention.

A. Applicants contend that the Hirni patent does not show creating a temporary conference and "directing the audio stream of the conference to the sidebar conference.

B. Applicant contends that the cited references of Hirni and Meredith do not teach or suggest all the claim limitations, and there must be some suggestion or motivation to combine the cited references. Neither patents separately or individually teach the limitations of the claims and it is not possible to establish prima facie case of obviousness.

6. As to "Point A" it is the position of the Examiner that although the Hirni does not teach all details of the limitation, the Beyda patent does so brilliantly [see Beyda, column 7, lines 28-55]. However, in view of Applicant's remarks, Applicant's arguments are deemed moot in view of the following new grounds of rejection as explained above in claims 1, 6, 15, 16 and 17

As to "Point B", Examiner's position the examiner respectfully agrees with the applicants and removed the rejection under 35 U.S.C. 103(a) over both Hirni and Meridith. However, the combination of Hirni and Beyda perfectly show all the limitations

Art Unit: 2143

of the claim language. As a result, a new rejection under 35 U.S.C. 103(a) over Hirni and Beyda is presented in light of the claims substantial amendment.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2143

8. Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3719.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Jude Jean-Gilles

Patent Examiner

Art Unit 2143

JJG



June 24, 2005



DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100